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REMARKS

In view of the above amendments and the following remarks, Applicants respectfully request review and reconsideration of the final Office Action mailed December 7, 2009 (hereinafter "Office Action"). This Response is accompanied by a Request for Continued Examination and credit card authorization to charge the $65 small entity fee for a retroactive one-month extension of time, the $130 fee for a 3 month suspension of action, and the $405 small entity fee for a request for continued examination. Although no additional fees are believed due, the Commissioner is hereby authorized to charge any deficiency or credit any surplus to Deposit Account No. 14-1437.

Applicants note that this Amendment is accompanied by a request for continued examination and request for a three month suspension of action and the required fees. Applicants will file a supplemental response prior to expiration of the three month suspension of action. Accordingly, although this Amendment is responsive to the Office Action, Applicants respectfully request that examination be carried out on the supplemental Amendment that will be filed prior to expiration of the three month suspension of action.

In the Office Action, claims 23-46 were pending and all claims were rejected under both 35 U.S.C. §101 and 35 U.S.C. §103. The rejections and responses thereto are discussed more fully below.

Claim Rejections – 35 U.S.C. §101

In the Office Action, claims 23-56 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. The Office Action asserts that in order for a method claim to fall within statutory subject matter, the claims must be tied to either a machine or transformation. It is asserted that a two-branched inquiry is used to show that a claim is statutory by either tying it to a particular machine or by a showing that the claim transforms an article. In addition, it is asserted that the use of a specific machine or transformation of an article must impose "meaningful limits" on the claims' scope to impart patent eligibility. The Office Action asserts that the involvement of the machine or transformation in the claimed process must not merely be

insignificant extra-solution activity, such as storing, gathering, displaying, sending and receiving of data as this does not impart to the process a significant impact in the solution.

Applicant notes that while the rejection outlines assertions regarding the standard set forth by *In re Bilski*, there is absolutely no analysis supporting a conclusion that the claims are drawn to non-statutory subject matter. As indicated in MPEP 706.03(a) a proper rejection under 35 U.S.C. §101 for failing to claim statutory subject matter should state that, "The claimed invention is directed to non-statutory subject matter because … ." As the Examiner has failed to provide any rationale supporting the rejection, Applicant respectfully requests that a non-final Office Action be issued if the instant rejection under 35 U.S.C. §101 is not withdrawn.

Although the Examiner's rationale is not disclosed, Applicant believes that *In re Bilski*, Docket No. 2007-1130, _____ (Fed. Cir., October 30, 2008) cannot be properly applied to the claimed methods. *In re Bilski* is a narrow decision that dealt with claims that, as argued by Bilski's counsel, were drawn to abstract techniques for hedging investment risk without the use of a computer. Thus, a holding that the subject matter at issue in *In re Bilski* was patentable subject matter would have been a holding that human thought processes could be patented. This would have been an absurd result that simply could not be justified. However, broad application of such a decision is equally unjustified.

As explained by the Court, in *In re Bilski*,

> We hold that the Applicants' process as claimed does not transform any article to a different state or thing. Purported transformations or manipulations simply of public or private legal obligations or relationships, business risks, or other such abstractions cannot meet the test because they are not physical objects or substances, and they are not representative of physical objects or substances. Applicants' process at most incorporates only such ineligible transformations.

In re Bilski at Page 28, Lines 1-6.

From this, it is apparent that "legal obligations or relationships, business risks, or other such abstractions," such as hedging risk, do not meet the transformation test. However, the Court also stated that, "So long as the claimed process is limited to a practical application of a fundamental principle to transform specific data, and the claim is limited to a visual depiction

that represents specific physical objects or substances, there is no danger that the scope of the claim would wholly pre-empt all uses of the principle." *In re Bilski* at Page 26, Lines 15-18.

In the instant case, the relevant data represents individual test takers and their credentials for acceptance into a graduate school through the claimed admissions method. As the relevant data represents individual test takers, the data is a transformation from individual test takers to descriptive data about the individual test takers. Furthermore, the claimed method requires a computer. As the claimed method meets the transformation prong of the machine or transformation test, and requires the use of a computer in a manner that cannot be classified as insignificant extra-solution activity, Applicant respectfully submits that the claims are drawn to statutory subject matter.

Applicant respectfully notes that the U.S. Supreme Court has granted *certiorari* to hear *In re Bilski* later this year and a decision is expected in early 2010. Accordingly, Applicant respectfully requests that any subsequent Office Action including a rejection under 35 U.S.C. 101 be issue after the Supreme Court's decision on the appeal of *In re Bilski*.

Claim Rejections – 35 U.S.C. §103

In the Office Action, claims 23-56 are rejected under 35 U.S.C. §103 as being unpatentable over Arenson, "Opponents of Change in CUNY Admissions Policy Helped Pass a Compromise Plan," November 24, 1999 (hereinafter "Arenson"), in view of www.gradcollege.swt.edu, February 29, 2000 (hereinafter "Grad College").

The claimed method for admission to a graduate school, as set forth in amended claim 23, is drawn to:

> 23. (currently amended) A method for admission to a graduate school, said method comprising the steps of:
>
> identifying a pool of standardized test takers who possess a GPA and standardized test score that are insufficient to gain regular admission to a graduate school ~~and who did not initially apply to the graduate school~~, wherein the identifying step is enabled by a computer product;
>
> offering a program for admission to the graduate school to the identified test takers, wherein the program for admission includes an abbreviated academic program;

providing instruction in at least one academic discipline to the test takers who accept the offer to participate in the program for admission;

subjecting test takers in the program for admission to at least one examination during the abbreviated academic program, each test taker in the program for admission achieving a score on the at least one examination, wherein each score is assigned using [[a]] an absolute calibrated grading process; and

admitting into the graduate school those test takers who achieve a score on said at least one examination which exceeds a pre-determined score deemed to correlate with academic success at the graduate school.

Prior to addressing the rejection, Applicant would like to review some relevant case law. The MPEP stresses the importance of considering the invention ***as a whole***. In section 2141.02, the MPEP instructs:

> In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

The MPEP clarifies that an invention is not considered "as a whole" when the Examiner falls prey to the temptation to distill the invention down to a "gist" or a "thrust." Section 2141.02. II. of the MPEP states:

> Distilling an invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the subject matter "as a whole." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (restricting consideration of the claims to a 10% per second rate of stretching of unsintered PTFE and disregarding other limitations resulted in treating claims as though they read differently than allowed); *Bausch & Lomb v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 447-49, 230 USPQ 416, 419-20 (Fed. Cir. 1986), *cert. denied*, 484 U.S. 823 (1987) (District court focused on the "concept of forming ridgeless depressions having smooth rounded edges using a laser beam to vaporize the material," but "disregarded express limitations that the product be an ophthalmic lens formed of a transparent cross-linked polymer and that the laser marks be surrounded by a smooth surface of unsublimated polymer."). See also *Jones v. Hardy*, 727 F.2d 1524, 1530, 220 USPQ 1021,

1026 (Fed. Cir. 1984) ("treating the advantage as the invention disregards statutory requirement that the invention be viewed 'as a whole'"); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987) (district court improperly distilled claims down to a one word solution to a problem).

As is noted in the discussion to follow, substantial portions of the rejection based on Arenson and Grad College attempt to distill the invention down to a "gist," rather than considering the claims as a whole. For example, the rejection summarily dismisses certain claim elements as well-known, ignores other claim elements, and breaks the claims into unrecognizably small parts rather than considering the interrelated phrases that make up the claimed method as a whole, which is necessary to achieve a completely unexpected result as explained below in the "Secondary Considerations" section of this Amendment.

A *prima facie* case of obviousness requires (1) a motivation or suggestion to combine the teachings of the references, (2) a reasonable expectation of success, and (3) that the prior art references, or knowledge of one skilled in the art, must teach or suggest all of the claim limitations. *See* MPEP §2143. An obviousness rejection cannot be sustained if any of these elements is not established or the applicant can rebut any of the elements with objective evidence of nonobviousness. Thus, Applicant respectfully requests thorough consideration of the declarations regarding objective evidence of nonobviousness submitted herewith.

As presented in the following discussion, the combination of Arenson and Grad College does not disclose or suggest: (i) absolute calibrated grading of examinations, (ii) offering a program for admission consisting of an abbreviated academic program that the test takers may participate in without a personal recommendation from a graduate advisor, (iii) offering a program for admissions having a duration of five to seven weeks, or (iv) any combination of these elements. Accordingly, Applicant believes that all claims are drawn to allowable subject matter.

Before addressing the assertions in the Office Action, it is important to note that the Arenson article deals with a legislated compromise to address a difficult transitional situation: increased standards for admission to CUNY senior colleges. Because Arenson deals with such a

specific situation, individuals of ordinary skill in the art would understand that the Arenson approach to the transition is not being advocated as an admissions program and would not combine Arenson with traditional admissions approaches, such as Grad College. Thus, Arenson teaches away from the combination relied upon in the rejection.

As is clear from Arenson, without the compromise the increased admission standards would not have been ratified because the new admission standards effectively revoked the acceptances of 248 students to CUNY senior colleges. *See* Arenson, paragraph 7. The compromise described by Arenson was an emergency, one-time approach for dealing with the politically volatile situation created by the increased admission standards that would have revoked admissions to 248 students shortly before the students were scheduled to enter college. *See* Arenson, paragraphs 1 & 4-6. There is nothing in the article to indicate that the Arenson approach provided a workable or desirable approach to either side. The approach was merely a concession to satiate those who vigorously opposed the impact the increased admission requirements had on the 248 students who were previously admitted to CUNY senior colleges and would have been forced to delay their college educations because of the timing of the increased admissions standards. *See* Arenson, paragraphs 4-6. Even so, the article indicates that the legislated compromise was unacceptable to the educators involved. *See* Arenson, paragraphs 4-6 and 11-end. A person of skill in the art would understand that the compromise described in Arenson was an unacceptable compromise to deal with a very specific temporary situation, rather than a new admissions program. Accordingly, even if Arenson did disclose what the Office Action asserts, there would be no motivation to combine Arenson with any other admissions program, including Grad College. Furthermore, the claimed method fills a long-felt, but unresolved need by producing an unexpected result that could not have been predicted from any combination of the cited references.

Arenson indicates that as part of the compromise, CUNY's undergraduate program offered some students who were previously admitted to CUNY, but who did not meet the increased admissions standards, an opportunity to take remedial classes in order to improve their scores on an admissions test. Arenson does not disclose or suggest identifying individuals with

numerical credentials that are insufficient to gain regular admission to a graduate school. In fact, the only reason these 248 individuals were being given this chance was that *their acceptances to CUNY senior colleges were revoked when the admission requirements were increased after the admissions process had concluded*.

In addition, Arenson deals with undergraduate education, not graduate education. Some people of ordinary skill in the art believe that students are entitled to an undergraduate education, even if remedial classes are necessary to prepare the individual for undergraduate classes. This is generally justified as a necessary correction for the public school system's failure to address the needs of these individuals who are unprepared for an undergraduate education. However, this belief and justification does not extend to graduate education. *Administrators of graduate schools require that test takers possess certain skills and knowledge prior to admitting them to the graduate school.*

In contrast to the compromise disclosed by Arenson, Applicant Harbaugh's claimed method of admissions is capable of identifying those test takers who possess insufficient numerical credentials (GPA and standardized test scores), but possess the necessary knowledge and skills to succeed in graduate school. *See* Declaration Under 37 C.F.R. 1.132 by Richard A. Matasar dated November 12, 2008 ("Second Matasar Declaration") and Declaration Under 37 C.F.R. 1.132 by Richard A. Matasar dated December 31, 2008 ("Harbaugh Declaration"). This is an unexpected result that is neither disclosed nor suggested by Arenson or any other cited reference. As explained by the Federal Circuit in *In re Rijckaert*, "Obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established." *In re Rijckaert*, 9 F.2d 1531, 1534 (Fed. Cir. 1993); *see* MPEP 2141.02.V. This unexpected result was not known at the time Applicant Harbuagh discovered the result was achieved by the claimed method.

Additionally, there is no motivation, suggestion or teaching in the cited references or the knowledge of one having ordinary skill in the art to combine references to reach the claimed invention. In particular, because one of ordinary skill in the art would discard the Arenson

transitional approach as an ***unacceptable political solution*** that is not supported by educational theory and has not been adopted subsequently.

Grad College provides for conditional admission decisions at Southwest Texas State University for applicants who do not meet the GPA and Graduate Record Exam (GRE) requirements. Conditional admissions decisions made using the Grad College reference are limited to individual test takers and are only available where the test taker (a) files an application, (b) seeks out the graduate advisor of the desired degree program, and (c) convinces the relevant graduate advisor to recommend conditional admission based on some evidence the test taker can succeed in the graduate program. Grad College does not provide any motivation or suggestion to offer a program for admission where test takers possessing inadequate numerical credentials are automatically enrolled if they achieve a pre-determined score on an examination or examinations administered during the program for admission and scored using an absolute calibrated grading process. Grad College does not provide any motivation or suggestion for offering a program for admission for test takers who score a pre-determined absolute calibrated score on an examination or examinations, where the pre-determined score is selected to correlate with a final exam score in a course covering the at least one academic discipline for regularly admitted students at the graduate school who have successfully completed one year at the graduate school. Finally, Grad College clearly does not provide any motivation, suggestion or teaching for a combination of these two claimed elements.

As noted above, the knowledge of one of ordinary skill in the art leads graduate schools to request the names of test takers whose GPA and standardized test score meet or exceed the admissions requirements of the graduate school. These individuals are invited to apply for admission to the graduate school. Thus, the knowledge in the art provides no motivation or suggestion to (1) identify a group of test takers who possess numerical credentials that do not meet a graduate school's admission requirements, or (2) to invite this group of test takers to participate in the claimed program for admissions, where each test taker that accepts the invitation is allowed the opportunity to be admitted to the graduate school without the need to file a conventional application for admission or a recommendation from a graduate advisor.

In the Office Action, the Examiner takes official notice that "it is old and well-known in the art of admissions to purchase or gain access to a list of students in a particular category in order to target enrollment." *See* Office Action, page 3. The first problem with this attempt at official notice is that the Examiner is attempting to use official notice of a general concept ("particular category") to disclose an entire complex, claim limitation. In *In re Ahlert*, 424 F. 2d 1088, 1091 (CCPA 1970), the Federal Circuit's predecessor held that, "Typically, it is found necessary to take notice of facts which may be used to supplement or clarify the teaching of a reference disclosure, perhaps to justify or explain a particular inference to be drawn from the reference teaching." In the present case, the Examiner is attempting to use official notice to disclose the limitation of "identifying a pool of standardized test takers who possess a GPA and standardized test score that are insufficient to gain regular admission to a graduate school." It should be abundantly clear that this is an attempt to take Official Notice *as the teaching*, not to clarify the teaching of an actual reference.

Another problem with this example of official notice is that, even if we assume that the Examiner's statement is accurate, the relevant claim language deals with identifying a pool of test takers "who possess a GPA and standardized test score that are insufficient to gain regular admission to a graduate school." In his declaration submitted August 24, 2005, Mr. Philip D. Shelton, CEO of the Law School Admission Counsel stated:

> Nova Southeastern identifies AAMPLE® candidates by using the CRS databased to search for persons with low LSAT scores who are unlikely to get admitted to any law school. I am unaware of any other law school or other academic institution that conducts a search for "under-qualified" students, particularly students who did not initially apply to the academic institution.

Shelton Declaration, Section 7.

Mr. Shelton goes on to state that, "The claimed methods are more effective at identifying students with a lower LSAT score who perform at the high end of the bell curve [for each LSAT score] more effectively than any other admissions method of which I am aware." Shelton Declaration, Section 7. ***Applicant notes that searching for individuals with GPAs and standardized test scores that are insufficient to gain regular admission to the graduate school***

simply does not make any sense absent that ability to successfully identify which students with GPAs and standardized test scores that are insufficient to gain regular admission to the graduate school will perform at the level of those who do possess sufficient GPAs and standardized test scores. The traditional approach for a graduate school to expand its applicant pool is to lower its standards and solicit individuals who meet the modified standards.

Because others have been unable to identify a better method of identifying individuals who will succeed in a graduate school despite a low GPA and test score, other academic institutions have not sought out such individuals. As explained in the attached Harbaugh Declaration and the Second Matasar Declaration, the claimed method as a whole has unexpectedly solved this problem.

As noted in the Reply to Office Action filed April 30, 2007, Official Notice is only appropriate where the subject matter of the notice is "capable of such instant and unquestionable demonstration as to defy dispute." *In re Ahlert*, 424 F. 2d 1088, 1091 (CCPA 1970). In the Office Action, the Examiner completely ignores very specific statements made by Mr. Shelton, a recognized expert in the field of graduate school admissions, based on her official notice regarding some vague concept of searching for students in a "particular category" in order to target enrollment. This is clearly outside the scope of when official notice is appropriate, *i.e.* where the subject matter of the official notice is "capable of such instant and unquestionable demonstration as to defy dispute" Furthermore, the ability to seek-out students in a "particular category" does not make it obvious to create an entire admissions program based on identifying non-applicant, test takers who do not meet the graduate school's admissions requirements. Without the unexpected benefit of the claimed method, such an approach would defeat the entire purpose of having admission standards.

Applicant respectfully traverses any assertion that graduate schools conduct searches for test takers with standardized test scores and undergraduate GPAs that are insufficient to gain regular admission to graduate schools. Applicant's position is supported by the sworn statements of Philip D. Shelton, CEO of the Law School Admissions Counsel (LSAC) at the time the statements were made. Over the thirty-two years preceding his Affidavit, Affiant Philip D.

Shelton had been continuously and intimately involved in graduate school admissions as a law school dean, as a senior member of LSAC, and as C.E.O. of LSAC. In his positions as law school dean and CEO of the LSAC, Mr. Shelton was in constant contact with law school deans and administrators who were (a) searching for the names of potential admissions candidates, and (b) experimenting with new ways to make admissions decisions. In Mr. Shelton's extensive experience, he unequivocally states that Nova Southeastern University's Shepard Broad Law Center is the only graduate school he has known or heard of that has ever requested names of students with GPAs and standardized test scores clearly outside the range of those acceptable to the requesting graduate school or graduate schools in general. *See* Affidavit of Philip D. Shelton, paragraph 7. ***The Examiner has provided no evidence to rebut Dr. Shelton's statements, just an attempt to use Official Notice.***

Applicant respectfully asserts that Mr. Shelton can be considered nothing less than a prominent expert in the relevant art. The Office Action is trying to take official notice of something that Mr. Shelton expressly stated was unknown to him without any evidence to support the Examiner's assertions. Clearly, such "facts" are not "capable of instant and unquestionable demonstration as being well-known" and do not meet the requirements set forth for official notice under MPEP 2144.03. Accordingly, the MPEP requires that the Examiner provide documentary evidence in the next Office action if the rejection is to be maintained on this ground, *see* MPEP 21440.3.C.

The MPEP requires that where official notice is traversed, "the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained." MPEP 21440.3.C. Applicant requested such documentary evidence in page 15 of the Response to Office Action filed April 30, 2007 and the Response to the Office Action mailed August 13, 2007; however, no such evidence has been proffered by the Examiner.

Clearly, the cited references do not disclose or suggest each element of the claimed invention. Clearly, neither the cited references nor the knowledge of one skilled in the art provide any motivation or suggestion to combine Grad College, or any other cited reference,

with other references to create the claimed method of admission. Accordingly, Applicant respectfully submits that all claims are drawn to allowable subject matter.

Secondary Considerations

If the Examiner concludes that the cited references establish a prima facie case of obviousness, which they do not, Applicant respectfully submits that there are secondary considerations, including commercial success, unexpected results, the failure of others and long-felt but unresolved needs, that rebut such a *prima facie* case of obviousness. *See* MPEP §716.01(a). These objective *indicia of nonobviousness* are discussed in more detail below.

With respect to commercial success, Applicant directs the Examiner to the Harbaugh Declaration submitted herewith. Applicant Harbaugh explains that the subject matter of the claims was implemented by Nova Southeastern University's Shepard Broad Law Center (the "Nova Law Center") and, shortly thereafter, the Nova Law Center began licensing the claimed methodology to numerous law schools including, New York Law School, Florida Coastal Law School, Albany Law School, and the University of LaVerne College of Law. *See* Harbaugh Declaration, Section 5. Applicant notes that, because the prior art methods are in the public domain for free, these law schools chose to license the claimed methodology because of the features that distinguish it from the prior art. *See id.*

Applicant Harbaugh declares that:

> The license revenue generated to date is ***at least $285,000***. In order to place this figure in context, it is important to recognize that the Nova Law Center is a law school and is not in the business of licensing admissions programs. In fact, the Nova Law Center has no formal marketing or sales program in place for licensing the claimed method. Thus, the $285,000 in revenue and the number of law schools licensing the program is reflective of the merits of the claimed method, word of mouth, and the fact that the claimed method successfully fills a much needed gap in conventional admissions methods.

Harbaugh Declaration, Section 5.

Thus, without any formal marketing or sales activity, Nova Law Center has generated at least $285,000 worth of revenue by licensing the claimed methodology. Applicant Harbaugh

also notes that, "in addition to the licensing revenue, the Nova Law Center has been approached by others seeking to purchase or exclusively license the claimed admission method in order to market the claimed method to the entire law school community. While nothing has been finalized, these negotiations are on-going. Based on my conversations with individuals involved in licensing the claimed method from the Nova Law Center, the commercial success and commercial interest to date is based solely on features that distinguish the claimed method from the cited references and other similar programs." *See* Harbaugh Declaration, Section 5.

Declarant Matasar is Dean of New York Law School, one of the law schools that license the claimed method from Nova Law Center. New York Law School has licensed the claimed method from Nova Southeastern Law Center each year since 2004. Under the license, up to 25 students per section who would not otherwise be admitted by New York Law School because of insufficient academic qualifications (LSAT, GPA, etc.) are allowed to participate in the claimed method, which is administered by Nova Southeastern Law Center. *See* Second Matasar Declaration, Section 4. Dean Matasar explained that because the program costs $35,000 per section, New York Law School closely scrutinizes the benefits of the claimed program. *See id.* However, even after scrutinizing the expenditure, "year-after-year New York Law School has decided that the unique features of the claimed admissions method provide a substantially improved admissions method that justifies this substantial cost by identifying students with insufficient academic qualifications for admission to New York Law School who perform at or above the level of students with significantly better academic qualifications." *See id.* In view of the lack of marketing or sales efforts, this level of commercial success on the basis of the unique features of the claimed method constitutes strong objective evidence of nonobviousness.

As noted by Applicant Harbaugh, there is an emerging recognition among graduate educators that education is enhanced when students are immersed in a diverse, high-performing student population. *See* Harbaugh Declaration, Section 5. It is also well documented that there is a level of cultural bias inherent in the standardized tests currently used for graduate admissions. In order to produce the desired diverse, high-performing student population,

graduate educators and test designers have endeavored to eliminate the cultural bias from standardized tests. To date, cultural bias has not been eliminated from standardized tests. *See id.*

In order to provide some additional context to the long-felt need satisfied by the claimed method, which identifies students performing at the high end of the bell curve represented by their LSAT and UGPA scores, Applicant Harbaugh provides an overview of the U.S. Supreme Court's decision in *Grutter v. Bollinger*, 539 U.S. 306 (2003). In *Grutter*, the issue of how to develop a diverse, high-performing student population was before the U.S. Supreme Court. In *Grutter*, the University of Michigan Law School ("UMLS") determined, "based on its experience and expertise, that a 'critical mass' of underrepresented minorities is necessary to further its compelling interest in securing the educational benefits of a diverse student body." *Grutter*, 539 U.S. at 333. Thus, the UMLS began considering race as one or a number of factors for making admissions decisions. The issue in *Grutter* was whether UMLS's admissions plan was constitutional. In order to pass constitutional scrutiny, the UMLS admissions plan needed to meet the requirements of narrow tailoring, including serious consideration of race-neutral alternatives. *See id.* Ultimately the Supreme Court determined that UMLS's admissions plan survived strict scrutiny and was constitutional. Although the Supreme Court ruled in favor of UMLS, there is still concern in the graduate school community, and law school community in particular, regarding what constitutes "serious consideration of race-neutral alternatives." *See* Harbaugh Declaration, Section 5.

Applicant Harbaugh states that, "while race may be taken into account [in admissions decisions], serious consideration must be given to race-neutral alternatives for eliminating cultural bias and developing a diverse, high-performing student population." *See* Harbaugh Declaration, Section 5. This is evidence of the long-standing need and failure of others with regard to identifying a method of identifying students who perform at the level students who scored substantially better using traditional predictors, such as UGPA and standardized test scores.

As additional evidence of the long-felt, but unresolved need in the admissions industry, Philip D. Shelton, then-C.E.O. of the LSAC, the group that administers the LSAT, states that the

LSAT is the best standardized admission test in the admission testing industry. *See* Affidavit of Philip D. Shelton. The score a test taker achieves on the LSAT, while representing a bell curve centered on that value, is indicative of the most likely level of performance in law school. Thus, like all bell curves, a significant percentage of test takers with a given score will perform better than the mode, *i.e.*, the performance level of the test taker with a given score having the average performance level in law school.

Mr. Shelton states that ***even after extensive research, the LSAC has been unable to identify a single variable or combination of variables that will identify test takers who will significantly outperform test takers with much higher scores.*** *See* Affidavit of Philip D. Shelton, paragraph 4. Mr. Shelton goes on to state:

> The claimed methods [of the present invention] are more effective at identifying students with a lower LSAT score who perform at the high end of the bell curve more effectively than any other admissions method of which I am aware. In short, the AAMPLE® program incorporating the claimed methods presents a method that has proven successful for identifying "diamonds in the rough" who will perform well at law school despite a relatively low LSAT score.

See Affidavit of Philip D. Shelton, paragraph 6.

As noted above, the LSAT is the best standardized admissions test in the industry. Thus, if the LSAT cannot identify high-performing, low-scoring test takers, neither can the MCAT, DAT, VCAT, PCAT, AHPAT, GRE, or the GMAT. In fact, the need for the method of the present claims would be even greater for these other admissions tests.

Applicant now turns to evidence of unexpected results and proof that the claimed method meets the long-felt need in the prior art and succeeds where others have failed. As explained by the Federal Circuit in *In re Rijckaert*, "Obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established." *In re Rijckaert*, 9 F.2d 1531, 1534 (Fed. Cir. 1993); *see* MPEP 2141.02.V. As noted by Mr. Philip Shelton while serving as C.E.O. of the Law School Admission Counsel, "The claimed methods are more effective at identifying students with a lower LSAT score who perform at the high end of the bell curve [for each LSAT score] more effectively than any other admissions method of which I am aware." Declaration of Mr. Philip D. Shelton submitted August 24, 2005, Section 7.

Mr. Shelton explains that this is true even though the LSAT is the most predictive standardized test in the industry. *See* Shelton Declaration, Section 3. "The LSAC has conducted extensive research over many years, however, no single variable or combination of variables has been identified that allows a law school admission office to consistently identify 'diamonds in the rough.'" *See* Shelton Declaration, Section 4.

Even with all of the research efforts expended by Mr. Shelton, the LSAC, and the other standardized testing organizations, no one has been able to consistently identify those individuals who would score at the high end of the bell curve for a given LSAT score and UGPA. Applicant submits the Second Matasar Declaration and the Harbaugh Declaration to demonstrate that the claimed method unexpectedly provides this highly coveted result.

In his Declaration, Dean Matasar explains that the first class of graduates admitted through the claimed program did not graduate until June 2008. *See* Second Matasar Declaration, Section 3. These graduates include two students admitted in 2004 who participated in New York Law School's part-time program, which requires four-years to complete.

According to Dean Matasar, the number and status of students admitted to New York Law School through the claimed program since 2004 is as follows:

Year	Students Participating	Students Admitted	Status of Admitted Students
2004	14	3	2 graduated June 2008 1 dismissed
2005	9	4	3 graduated June 2008 1 enrolled in part-time program
2006	17	7	7 active students
2007	18	0	N/A
2008	26	17	To Be Determined

See Second Matasar Declaration, Section 3.

Prior to addressing the academic performance of these students once admitted to New York Law School, Dean Matasar felt is was important to compare their LSAT scores and UGPAs to the averages for students granted regular admission to New York Law School. *See id.* For example, in 2007, students admitted to New York Law School had an average LSAT score of 154, whereas students admitted to New York Law School through the claimed program had an

average LSAT score of 146. Thus, based solely on their academic qualifications, LSAT and UGPA, the students admitted through the claimed program would have been expected to perform substantially worse academically than regularly admitted students. *See id.*

As explained by Dean Matasar, "In contrast to these low expectation, nine of the fourteen students who have completed their first year at New York Law School achieved a first year GPA of at least 3.0 out of 4.0. This is particularly impressive considering that the mean GPA for the first year class is approximately 2.8 out of 4.0. Thus, the students admitted using the claimed method achieved academic results that were substantially better than expected. In other words, the program has successfully identified students performing at the high end of the curve for their respective LSAT score." Second Matasar Declaration, Section 3.

In addition, 30 of the 31 students admitted through the claimed admissions program are still enrolled at New York Law School. This equates to an attrition rate of less than 4%. *See id.* Even if only those students admitted who have completed two years at New York Law School are considered, the attrition rate of those students is only 7% (1 out of 14). This is significantly less than New York Law School's average attrition rate of approximately 15%. *See id.* Thus, based on Dean Matasar's Second Declaration, it is clear that the method has successfully identified test takers who will perform at the level of individuals with substantially high UGPAs and standardized test scores.

As explained by Applicant Harbaugh, the Shepard Broad Law Center at Nova Southeastern University ("Nova Law Center") implemented the claimed admissions method in the Fall of 2001. *See* Harbaugh Declaration, Section 4. Since the claimed method was implemented, there have been 572 students admitted to the Nova Law Center through the program. Of those, 95.45% have either graduated or are currently enrolled at the Nova Law Center. This compares favorably with the 90.4% retention rate for the 1740 students admitted through regular admissions during the same period. *See id.*

Applicant Harbaugh notes that using the claimed methods, where the pre-determined score was selected to reflect final exam grades achieved by regularly admitted students who had successfully completed the first year of law school, students admitted using the claimed method

have first year law school GPAs (hereinafter "1L GPA") equal to those of students admitted through regular admissions. *See* Harbaugh Declaration, Section 3. In fact, the following chart shows the average LSAT scores and average first year GPA (1L GPA) for students admitted through both programs for the period from 2004 to 2007.

	Claimed Method	Regular Admission
Avg. LSAT	142	151
Avg. 1L GPA	2.59	2.61

See Harbaugh Declaration, Section 3.

The data from 2004 to 2007 clearly demonstrates that the claimed method identifies the high performing standardized test takers from a group of low scoring standardized test takers. Applicant Harbaugh explains that, given the variability in both groups, the performance of students admitted through the claimed method and through regular admissions are essentially identical. *See id.* This is true even though the students admitted through the claimed method scored on average more than thirty percentile points lower than those admitted through Nova Law Center's regular admissions program. *See id.*

Finally, Applicant Harbaugh states that "it is clear that the claimed method of admissions successfully identifies students performing at the high end of the bell curve represented by their LSAT score. This is an unexpected result and an unequivocal success where others have failed, especially considering all of the resources expended by standardized testing organizations attempting to obtain this result of the claimed method." *See* Harbaugh Declaration, Section 3. Applicant respectfully submits that the declarations of Dean Matasar and Applicant Haraugh, submitted herewith, are powerful evidence that the claimed method unexpectedly identifies students performing at the high end of the bell curve for their given standardized test and UGPA scores. This constitutes powerful objective evidence of non-obviousness.

In response to the above secondary considerations, the Office Action asserted that Applicant has not shown that the claimed invention has successfully identified students who will perform better than higher test scorers in an actual law program. *See* Office Action, paragraph 30. Applicants respectfully submit that the Harbaugh Declaration and the Second Matasar Declaration overcome this objection.

Thus, even if the cited references did meet the elements of a *prima facie* case of obviousness, which they do not, Applicant believes that these secondary considerations of commercial success, unexpected results, the failure of others and long-felt but unresolved needs rebut such a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests allowance of all pending claims.

Conclusion

For at least the reasons set forth above, the independent claims are believed to be allowable. In addition, the dependent claims are believed to be allowable due to their dependence on an allowable base claim and for further features recited therein. The application is believed to be in condition for immediate allowance. If any issues remain outstanding, Applicant invites the Examiner to call the undersigned if it is believed that a telephone interview would expedite the prosecution of the application to an allowance.

Respectfully submitted,

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